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In re Application of BRISCO et al :
U.S. Application No.: 10/552,790 :
PCT Application No.: PCT/US2004/010712 :
Int. Filing Date: 06 April 2004 :
Priority Date Claimed: 08 April 2003 : DECISION
Attorney Docket No.: 25791.272.06 :
For: APPARATUS FOR RADially :
EXPANDING AND PLASTICALLY :
DEFORMING A TUBULAR MEMBER :

This is in response to applicant's "Petition under 37 C.F.R. § 1.182" filed 28 August 2007.

BACKGROUND

On 06 April 2004, applicant filed international application PCT/US2004/010712, which claimed priority of an earlier United States application filed 08 April 2003. The thirty-month period for paying the basic national fee in the United States expired on 11 October 2005 (08 October 2005 was a Saturday preceding a Monday holiday).

On 11 October 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1), a substitute specification, and an authorization to charge any fees which may be required to a deposit account.

On 26 May 2006, applicant's deposit account was debited for excess claim fees.

On 28 August 2007, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

37 CFR 1.26(a) states in relevant part,

The Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party

desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

A review of international application PCT/US2004/010712 reveals that the application contained 537 claims. A proper amendment reducing the number of claims was never submitted in the international application.

MPEP 1893.01(c) states in relevant part,

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492**>(d)-(e)< and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492**>(f)<. A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608. (Emphasis added.)

In the present case, the initial national stage submission on 11 October 2005 did not include a proper preliminary amendment. However, it is apparent from the papers filed 11 October 2005 that applicant sought to reduce the number of claims for examination at the time of national stage entry. Specifically, the substitute specification contained a listing of 32 claims, rather than the 537 claims contained in the international application. Furthermore, the transmittal letter (Form PTO-1390) contained a payment calculation based on the presence of 32 claims as opposed to 537 claims. A proper preliminary amendment was filed with the present petition, reducing the total number of claims to 32. Because of applicant's intent to reduce the number of claims for examination and because the fees paid towards the examination of claims are not remotely commensurate with number of claims that remain for examination, justice in the present case requires waiver of the requirement that a preliminary amendment must accompany the initial national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees. Accordingly, the claim fees paid based on the presence of the original 537 claims, less the claim fees based on the remaining 32 claims, are deemed to be in excess of that required, and refund of such excess under 37 CFR 1.26(a) is appropriate.

A review of the fee records for the present application reveals that \$37,750.00 has been paid for excess claim fees. The application currently contains 32 independent claims. Thus, a fee of \$600.00 for 12 claims in excess of 20 is required, and a fee of \$5,800.00 for 29 independent claims in excess of 3 is required. A total of \$31,350.00 will be refunded to Deposit Account No. 08-1394.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision and will be forwarded to Technology Center AU 3676 for examination in due course.

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